

Sections 1.177, 1.312(b), 1.313(a), and 1.314 are being amended to replace the references to § 1.17(i)(1) with references to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.316(d) is being amended to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.316(b) not filed within six (6) months of the date of the abandonment of the application. Acceptance of a late payment of an issue fee in a design application is specifically provided for in § 1.155. Therefore, § 1.316 does not apply to design applications. The language "filed before June 8, 1955" as used in the amended rule, refers to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121 or 365.

Section 1.317(d) is being removed and reserved to eliminate the requirement that a terminal disclaimer accompany any petition under § 1.317(b) not filed within six (6) months of the date of lapse of the patent.

Section 1.666 is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.701 is being added to set forth the procedure the PTO will follow in calculating the length of any extension of patent term to which an applicant is entitled under 35 U.S.C. 154(b) where the issuance of a patent on an application, other than for designs, filed on or after June 8, 1995, was delayed due to certain causes of prosecution delay. Applicants need not file a request for the extension of patent term under § 1.701. The extension of patent term is automatic by operation of law. It is currently anticipated that applicant will be advised as to the length of any patent term extension at the time of receiving the Notice of Allowance and Issue Fee Due. Review of the length of a patent term extension calculated by the PTO under § 1.701 prior to the issuance of the patent would be by way of petition under § 1.181. If an error is noted after the patent issues, patentee and any third party may seek correction of the period of patent term granted by filing a request for Certificate of Correction pursuant to § 1.322. The PTO intends to identify the length of any patent term extension calculated under § 1.701 on the printed patent.

Section 1.701(a) is being added to identify those patents which are entitled to an extension of patent term under 35 U.S.C. 154(b).

Section 1.701(b) is being added to provide that the term of a patent entitled

to extension under § 1.701(a) shall be extended for the sum of the periods of delay calculated under §§ 1.701 (c)(1), (c)(2), (c)(3) and (d), to the extent that those periods are not overlapping, up to a maximum of five years. The section also provides that the extension will run from the expiration date of the patent.

Section 1.701(c)(1) is being added to set forth the method for calculating the period of delay where the delay was a result of an interference proceeding under 35 U.S.C. 135(a). The period of delay with respect to each interference in which the application was involved is calculated under § 1.701(c)(1)(i) to include the number of days in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application. An interference is considered terminated as of the date the time for filing an appeal under 35 U.S.C. 141 or civil action under 35 U.S.C. 146 expired. If an appeal under 35 U.S.C. 141 is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the PTO. If a civil action is filed under 35 U.S.C. 146, and the decision of the district court is not appealed, the interference terminates on the date the time for filing an appeal from the court's decision expires. See section 2361 of the MPEP. The period of delay with respect to an application suspended by the PTO due to interference proceedings under 35 U.S.C. 135(a) not involving the application is calculated under § 1.701(c)(1)(ii) to include the number of days in the period beginning on the date prosecution in the application is suspended due to interference proceedings not involving the application and ending on the date of the termination of the suspension. The period of delay under § 1.701(a)(1) is the sum of the periods calculated under §§ 1.701 (c)(1)(i) and (c)(1)(ii), to the extent that the periods are not overlapping.

Section 1.701(c)(2) is being added to set forth the method for calculating the period of delay where the delay was a result of the application being placed under a secrecy order.

Section 1.701(c)(3) is being added to set forth the method for calculating the period of delay where the delay was a result of appellate review. The period of delay is calculated under § 1.701(c)(3) to include the number of days in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed

under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

Section 1.701(d) is being added to set forth the method for calculating any reduction in the period calculated under § 1.701(c)(3). As required by 35 U.S.C. 154(b)(3)(B), § 1.701(d)(1) provides that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination. The "filing date" for the purpose of § 1.701(d)(1) would be the earliest effective U.S. filing date, but not including the filing date of a provisional application or the international filing date of a PCT application. For PCT applications entering the national stage, the PTO will consider the "filing date" for the purpose of § 1.701(d)(1) to be the date on which applicant has complied with the requirements of § 1.494(b), or § 1.495(b), if applicable.

As contained in Public Law 103-465, 35 U.S.C. 154(b)(3)(C) states that the period of extension referred to in 35 U.S.C. 154(b)(2) "shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner." Section 1.701(d)(2) is being added to provide that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. Section 1.701(d)(2) also provide that in determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review. Acts which the Commissioner considers to constitute *prima facie* evidence of lack of due diligence under § 1.701(d)(2) are suspension at applicant's request under § 1.103(a) during the period of appellate review and abandonment during the period of appellate review.

Section 3.21 is being amended to provide that an assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number,